Paper No. 22

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS AND INTERFERENCES

Ex parte HENRI SAMAIN, DANIEL BAUER and JEAN-MICHEL STURLA

Appeal No. 2003-0845
Application No. 09/689,818

ON BRIEF

Before ADAMS, MILLS, and GREEN, Administrative Patent Judges.

GREEN, Administrative Patent Judge.

DECISION ON APPEAL

An oral hearing in this case was scheduled for May 20, 2003. Upon reviewing the case, however, we have determined that an oral hearing will not be necessary and we render the following decision based on the record. See 37 CFR § 1.194(c).

This is a decision on appeal under 35 U.S.C. § 134 from the examiner's final rejection of claims 1-36 and 54-68. Claims 1 and 34 are representative of the subject matter on appeal, and read as follows:

1. A cosmetic composition comprising an aqueous dispersion of insoluble polymer particles and at least one insoluble silicone, wherein said insoluble polymer particles are present in a concentration greater than 15%, relative to the

total weight of said cosmetic composition, wherein the glass transition temperature of said insoluble polymer particles ranges from 15 to 35°C, and wherein said aqueous dispersion comprises polymer particles instead of polymers dissolved in a solvent.

34. A pressurized aerosol composition comprising an aqueous dispersion of insoluble polymer particles, at least one insoluble silicone, and at least one propellant agent, wherein said insoluble polymer particles are present in a concentration of at least 10%, relative to the total weight of said pressurized composition, and the glass transition temperature of said insoluble polymer particles ranges from 15 to 35°C.

The examiner relies upon the following references:

Yahagi et al. (Yahagi)	4,798,721	Jan. 17, 1989
Dubief et al. (Dubief)	5,160,730	Nov. 03, 1992
Hatfield et al. (Hatfield) (European Patent)	0,590,604	June 04, 1994

Claims 1-36 and 54-68 stand rejected under 35 U.S.C. § 103 as being obvious over the combination Dubeif, Yahagi and Hatfield. After careful review of the record and consideration of the issue before us, we reverse.

DISCUSSION

The Examiner's Answer states that claims 1-36 and 54-68 stand rejected under 35 U.S.C. § 103(a) for the reasons made of record in Paper No. 3. The rejection as set forth in Paper No. 3, however, does not address the limitation of the concentration of the insoluble polymer particles in the composition, which is one of the limitations in contention. We therefore look to the Examiner's Answer for the statement of the rejection. As the limitation was addressed by the Examiner in the Final Rejection, Paper No. 7, and addressed by appellants in the Appeal Brief, we find that the issue is properly before us on appeal.

According to the examiner, as set forth in the Examiner's Answer:

Dubeif [ ] shows those insoluble silicone claimed herein are useful in combination with a insoluble crosslinked polymer aqueous dispersion as hair treating composition (See particularly the abstract and the claims). The composition may further comprise surfactants, and other adjuvants such as polymers, synthetic oils, propellants conditioning agents. See, particularly, page column 9 [sic], lines 19-67. The composition pH is about 6-8. See the examples. The Dubeif reference and the claimed invention differ only in that Dubeif reference does not employ the particular polymer herein claimed in the selected concentration. However, Hatfield shows the particular polymer herein employed are old and well-known for theirexcellent [sic] properties imparted to hair, and are particularly useful in the form of aqueous dispersion in hair treating composition, and the concentration of polymer in the hair treating composition may be up to 25% by weight, well within the claimed concentration (See, particularly, the examples 38-46 and the claims therein). Also see page 5, lines 11-34. Yahagi reference show[s] [sic] the general state of art that employment of polymer particles in the form of aqueous dispersion with insoluble silicone is well known. In view of the teachings, and the state of art, it would be prima facie obvious to make a simple substitute of the polymer in Dubeif reference with the polymer in Hatfield in the form of aqueous dispersion for a hair spray composition. One of ordinary skill in the art would be motivated to make this substitution because of the excellent characteristics of the polymer herein, knowing the fact that polymer in particulate dispersion, along with silicone, is well-known for hair treating composition. There is absolutely no issue of destruction, or destroying of the original intended function.

Examiner's Answer, pages 3-4.

Appellants argue that "the prior art of record simply does not teach the combination of insoluble polymer particles in the claimed concentration and at least one insoluble silicone." Appeal Brief, page 6. Specifically, appellants argue that Dubeif teaches that the copolymer is present in a concentration between 0.1 and 10% by weight relative to the total weight of the dispersion, and the dispersion is only a part of the total composition. Therefore, appellants assert that the concentration of copolymer in the entire cosmetic composition as taught by Dubeif is much lower that appellants claimed composition. Because

the concentration of the copolymer with respect to the total composition is not taught by Dubeif, appellants conclude that the combination would result in the destruction of the intended operation in Dubeif, and is also the basis of an improper rejection under section 103. See Appeal Brief, pages 6-7. We agree.

The burden is on the examiner to make a prima facie case of obviousness, and the examiner may meet this burden by demonstrating that the prior art would lead the ordinary artisan to combine the relevant teachings of the references to arrive at the claimed invention. See In re Fine, 837 F.2d 1071, 1074, 5 USPQ2d 1596, 1598-99 (Fed. Cir. 1988). Obviousness is determined in view of the sum of all of the relevant teachings in the art, not isolated teachings in the art. See In re Kuderna, 426 F.2d 385, 389, 165 USPQ 575, 578 (CCPA 1970); see also In re Shuman, 361 F.2d 1008, 1012, 150 USPQ 54, 57 (CCPA 1966). In assessing the teachings of the prior art references, the examiner should also consider those disclosures that may teach away from the invention. See In re Geisler, 116 F.3d 1465, 1469, 43 USPQ2d 1362, 1365 (Fed. Cir. 1997).

The claims require that the insoluble polymer particles in a concentration of 15% (claim 1) or a concentration of 10% (claim 34). Dubeif teaches with respect to the copolymer:

> The water-in-oil emulsion containing the cross-linked ammonium acrylate/acrylamide (95/5 by weight) copolymer is preferably present in the aqueous dispersion in proportions such that the concentration of copolymer is between 0.05 and 10% by weight and preferably between 0.1 and 5% by weight of copolymer active substance, relative to the total weight of the dispersion.

Id. at Column 9, lines 6-12.

The examiner asserts that:

> [I]t is apparent the recited "dispersion" is cosmetic composition, not a minor ingredient of a cosmetic composition. Claim 1 of Dubeif reads "An aqueous dispersion intended for the cosmetic treatment of hair or the skin and/or in dermatology, which contains at least an organopolysiloxane, and a crosslinked ammonium acrylate/acrylamide copolymer, in a cosmetically or physiologically acceptable aqueous medium" (note no limitation regarding the amount of crosslinked polymer), and claim 18 reads "composition according to claim 1, intended for the treatment of hair which is in the form of shampoo, or rinsing product, to be applied before or after dyeing or bleaching, or as unrinsed styling products." This clearly indicates that the "dispersion" reads on cosmetic composition. Or the cosmetic composition is in the form of dispersion. (See also, column 9, lines 12-40). There is nothing in Dubeif reference to remotely suggest that the "dispersion" is merely a fraction of the final composition, as alleged by appellants.

Examiner's Answer, page 5.

We find that the examiner has improperly looked to the claims for a definition of "dispersion" rather than looking to the teachings of the specification. See, e.g., In re Benno, 768 F.2d 1340, 1346, 226 USPQ 683, 686 (Fed. Cir. 1985) ("The scope of a patent's claims determines what infringes the patent; it is no measure of what it discloses."). Looking to the examples of Dubeif, the examples employ a concentration of copolymer that is significantly lower than that required by the claims. Example 1 teaches a final concentration of

approximately 0.5% by weight of the final composition, based on the inclusion of 100g of water and only 0.5 g of the copolymer emulsion in the final composition. Example 4 appears to have the largest concentration by weight, as it contains 2g of copolymer, but also contains 100g of water in the final composition. So, at most, not considering the additional components of the final composition, the copolymer would be present in a concentration of 2% by weight, well below the 10% or 15% required by the instant claims.

The rejection also looks to Hatfield to teach the selected concentration, as well as the particular polymers required by the dependent claims. See Examiner's Answer, page 5. Hatfield teaches that:

> When the polymer compositions of the present invention are used in hairspray compositions, the concentration of copolymer in the hairspray composition is typically from about 1 to 25 weight percent, preferably from about 2 to 18 weight percent and more preferably from about 3 to 15 weight percent of the hairspray composition.

Id. at 5, lines 11-14.

The examiner relies on examples 38-46 of Hatfield to support the proposition that one would have been motivated to modify the polymer concentration of Dubeif to arrive at the claimed polymer concentration. Upon review of the examples relied upon by the examiner, it is unclear what the concentration of copolymer is used in Example 38, but examples 39-42 state that:

> The polymer composition of Example 9 was formulated in accordance with the procedure of Example 38 to provide hair

> spray compositions with ethanol concentrations of 0, 20 and 50 weight percent (examples 39 to 41) and a copolymer concentration of 4 weight percent.

Hatfield, page 10, lines 30-35. Examples 43-46 also do not teach a concentration of copolymer greater than 4% by weight.

Given the fact that Dubeif does not teach a copolymer concentration of copolymer greater than 2% in a cosmetic composition that also contains an insoluble silicone, and that Hatfield, although teaching that the concentration of copolymer may be up to 25%, does not provide examples having a concentration of copolymer over 4% by weight, one of ordinary skill in the art, when considering the combined teachings as a whole, would not have been motivated to go to the higher concentration ranges of copolymer, such as 10 or 15% by weight suggested, but not exemplified by Hatfield. The Yahagi reference is relied upon for showing the general state of the art, teaching that the employment of polymer particles in the form of aqueous dispersion with insoluble silicone is well known. Thus, Yahagi does not remedy the deficiencies of Dubeif and Hatfield.

CONCLUSION

Because the examiner has failed to set forth a prima facie rejection of obviousness, the rejection is reversed.

REVERSED

Donald E. Adams)
Administrative Patent Judge)
)
) BOARD OF PATENT
Demetra J. Mills)

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	)	
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